THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MANUEL PIRES and RUSSELL MOSKWA

Appeal No. 1996-3178
Application 08/407,275[1]

ON BRIEF

Before HAIRSTON, BARRETT and FRAHM, Administrative Patent Judges.

FRAHM, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 2 to 5, 7 to 9,

[1] Application for patent filed April 20, 1995. According to appellants, the application is a continuation of Application 08/099,837, filed July 29, 1993, now abandoned.

12 and 13, which constitute all of the pending claims in the application before us. Claims 1, 6, 10 and 11 were canceled by appellants in their amendment of September 7, 1994. We note that the copy of the appealed claims, claims 2 to 5, 7 to 9, 12 and 13, submitted with the Brief as an appendix, is incorrect. In addition to the minor errors noted by the examiner at page 2 of the Answer, we note the following additional errors:

In claim 4, line 1, "in claim 1" should be --in claim 12-- in accordance with appellants' amendment of September 7, 1994.

In claim 12, line 3, "a plurality a plurality" should be --a plurality-- in accordance with appellants' amendment of March 12, 1996.

BACKGROUND

The subject matter on appeal is directed to a storage system 1 (see appellants' Figure 1) for storing objects (e.g., keys 4) which are associated with identification devices 2 (e.g., an electronic memory). The identification devices 2 are attached to the objects or keys 4 with a wire 3, and engage into stations 6 on a frame 16 or housing 17 as shown in Figure 1. As further shown in Figure 1, storage system 1 includes a display means 13 and a keyboard or input means 12 for user interface. As stated by appellants at page 1 of the specification, the storing and keeping track of objects such as keys is a known problem for automobile dealers, hotels, hospitals, and the like. It was recognized in the prior art that it would be desirable to record the user of a key so that it cannot be lost due to various events such as employee turn-over. See specification, page 1.

Representative claim 12 is reproduced below:

12. A storage system suitable for storing a plurality of objects each associated with an identification device including electronic memory means operable for storing a unique readable code, said system comprising

a frame;

a plurality of station means in said frame operable to receive said identification devices;

reading means operable for reading the respective codes of electronic memory means;

input means operable for inputting information to respective electronic memory means to relate the associated code of each of said memory means to the associated object to said identification means and also for inputting information to respective electronic memory means as to a selected one of said identification devices or its associated object;

processing means operable for processing inputted information to said input means and for processing information from said reading means; and

display means responsive to said processing means and operable for indicating the location of an identification device engaged in one of said station means based on inputted information.

Representative claim 2 is reproduced below:

2. The storage system as claimed in claim 12, wherein said station means further comprises locking means operable to inhibit the disengagement of said identification device and responsive to said processing means.

The following references are relied on by the examiner:

Thomas	4,271,352	Jun. 2, 1981
Banks et al. (Banks)	4,635,053	Jan. 6, 1987
Saliga	5,038,023	Aug. 6, 1991

Claims 2, 3 and 7 to 9 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Saliga, Thomas, and Banks.

Claims 4, 5, 12 and 13 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Saliga and Thomas.

Rather than repeat the positions of appellants and the examiner, reference is made to the Brief and the Answer for the respective details thereof.[2]

OPINION

At the outset, we note that appellants (Brief, page 4) group and argue claims 2, 3 and 7 to 9 as standing or falling together, and group and argue claims 4, 5, 12 and 13 as standing or falling together. We are in general agreement with this grouping of the claims, and take claim 2 as being representative of the first group, and take claim 12 as being representative of the second group for purposes of our decision. See 37 CFR 1.192(c)(7).

In reaching our conclusion on the issues raised in this appeal, we have carefully considered appellants' specification and claims, the applied patents, and the respective viewpoints of appellants

[2] We note that the amendment submitted on March 12, 1996, accompanying the Brief, has been entered and considered by the examiner as indicated at page 2 of the Answer. We also note that the Revocation of Power of Attorney was received March 23, 1999, and a new power of attorney was entered as per the letter to appellants dated April 1, 1999, Paper no. 19.

and the examiner. As a consequence of our review, we are in agreement with the well reasoned statements of the examiner (final rejection, pages 3 to 4; Answer, pages 3 to 5) that the claims on appeal would have been obvious to one of ordinary skill in the art at the time the invention was made in light of the collective teachings of the applied references. For the reasons which follow, we will sustain the decisions of the examiner rejecting claims 2 to 5, 7 to 9, 12 and 13 under 35 U.S.C. § 103.

Rejection of Claims 4, 5, 12, and 13 Under 35 U.S.C. § 103:

We first turn to appellants' argument (Brief, page 4) that there is no motivation to combine Saliga and Thomas. Appellants simply state that Saliga identifies keys after a key is placed into storage whereas Thomas does not, and that therefore they have different goals and cannot be combined. We disagree. Both Saliga and Thomas pertain to key coding and tagging using electronic means in order to prevent loss, theft, access, and to keep track of information related to the owner and key itself. We find that it would have been obvious to one of ordinary skill in the art at the time of appellants' claimed invention to have employed the electronic memory concept of Thomas to the storage system taught by Saliga. The motivation would have been as given by the examiner, to store more information in a

limited area (final rejection, page 3). Thomas even teaches that bar codes and E PROM's are alternate and equivalent embodiments of his invention. Saliga and Thomas are both concerned with solving the same problem - that of using a computer to maintain records and other information pertinent to the key to which the identification device is attached. Accordingly, we cannot find error in the examiner's statement of the motivation for making the combination.

We turn next to appellants' argument (Brief, page 4) that the examiner fails to provide a reference or expert opinion supporting the proposition that bar codes are an art recognized equivalent to an electronic memory. We disagree with appellants. As set forth by the examiner (Answer, pages 4 to 5), Thomas is relied upon to show the equivalence of an electronic memory to bar codes. As discussed in Thomas at column 6, line 16 to column 7, line 21, many equivalent types of card coding can be used to associate an identification device and key with user data. Thomas teaches that some of these equivalent coding methods are magnetic stripe or tape (column 6, lines 6 to 15), optical character recognition (column 6, lines 16 to 39), bar code scanning systems (column 6, lines 40 to 56), electronically programmable read only memory or E PROM (preferred embodiment as discussed from columns 4 to 6 and shown in Figures 1 through 5), and embossed character recognition (column 7, lines 4 to 21). We find that one of ordinary skill in the art looking at the reference to Thomas would have clearly understood that an E PROM could be used in place of bar codes.

Rejection of Claims 2, 3, and 7 to 9 Under 35 U.S.C. § 103:

We turn next to appellants' argument (Brief, page 5) that there is no suggestion to combine Banks with Saliga or to combine Banks with Saliga and Thomas. Appellants aver that the examiner has not provided a reference to show that it would have been obvious to use a light source to locate keys. We cannot agree. Instead, we agree with the examiner that Banks teaches

a display means or LED light as an indicator to indicate to a user which key slot contains a requested key (see column 6, lines 7 to 10). As to motivation to combine the indicator teaching of Banks with Saliga and Thomas, we note our agreement with the examiner (Answer, page 4) that using an indicator is a quick way to notify a user about the location of a selected item/key. Furthermore, we note that it would have been common sense to use a light to locate the selected item/key since locating an item/key by row and column on a character display is tedious and time consuming. See In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969) (standing for proposition that conclusion of obviousness may be made from common knowledge and common sense of person of ordinary skill in art without any specific hint or suggestion in particular reference); In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968) and In re Shepard, 319 F.2d 194, 197, 138 USPQ 148, 150 (CCPA 1963) (both standing for proposition that not only specific teachings of reference but also reasonable

inferences which artisan would have logically drawn therefrom may be properly evaluated in formulating rejection).

We turn next to appellants' argument (Brief, page 4) that the examiner has not made it evident how Banks and Saliga could be structurally combined, and that instead the examiner is combining ideas and not technology. We note that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the

references. Rather the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In other words, the test is not what the individual references themselves teach, but rather what the combination of the disclosures taken as a whole would have suggested to one of ordinary skill in the art. In re McLaughlin, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). In the case before us, we find that the examiner has properly and sufficiently set forth a prima facie case of obviousness under 35 U.S.C. § 103. We find that representative claim 2 on appeal, which recites a locking means, would have been obvious in light of the collective teachings and concepts fairly suggested by Saliga and Banks. Banks

teaches a solenoid 26 for locking and unlocking an identification device and key 21 as claimed. Furthermore, we note that Saliga discusses a retaining latch for preventing unauthorized access as well as an indicator lamp to show item location (see column 1, lines 44 to 51). We agree with the examiner (Answer, pages 3 to 4) and find that it is the combination of teachings and concepts of Saliga and Banks, along with Thomas, that meets the language of the claims on appeal, and not the structural combination of the references.

Lastly, we consider appellants' argument (Brief, page 5) that the rejection is based on impermissible hindsight (i.e., the examiner's understanding founded on applicants' disclosure). It must be recognized that any judgement on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicants' disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). We cannot find any assertion in appellants' Brief that the reasoning of the obviousness rejection in the Office action took into account knowledge gleaned only from applicants' disclosure. In other words, it appears that applicants' hindsight argument is merely a general argument or assertion.

In any event, the artisan would have had no need for recourse to applicants' disclosure for direction to apply the teachings of either Thomas or Banks to a storage system as taught by Saliga. All that is involved is the application of knowledge clearly present in the prior art. See In re Sheckler, 438 F.2d 999, 1001, 168 USPQ 716, 717 (CCPA 1971).

In light of the foregoing, the differences between the subject matter recited in the claims and the references are such that the claimed subject matter as a whole would have been obvious within the meaning of 35 U.S.C. § 103. Accordingly, we shall sustain the standing rejections of claims 2 to 5, 7 to 9, 12 and 13 on appeal.

CONCLUSION

The decisions of the examiner rejecting claims 2 to 5, 7 to 9, 12 and 13 under 35 U.S.C. § 103 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

KENNETH W. HAIRSTON Administrative Patent Judge	))))) BOARD OF PATENT
LEE E. BARRETT Administrative Patent Judge	)) APPEALS AND)) INTERFERENCES
ERIC FRAHM Administrative Patent Judge	))

EF/pgg

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